



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/717,415	11/21/2000	Akihisa Kenmochi	14090	6487

23389 7590 10/05/2004

SCULLY SCOTT MURPHY & PRESSER, PC
400 GARDEN CITY PLAZA
GARDEN CITY, NY 11530

EXAMINER

DENNISON, JERRY B

ART UNIT PAPER NUMBER

2143

DATE MAILED: 10/05/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/717,415

Applicant(s)

KENMOCHI, AKIHISA

Examiner

J. Bret Dennison

Art Unit

2143

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 02 July 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-16 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-16 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. This Action is in response to Amendment for Application Number 09/717415 received on 02 July 2004.

1. Claims 1-16 are presented for examination.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1, and 14-16 are rejected under 35 U.S.C. 102(b) as being anticipated by Sims et al. (U.S. Patent Number 5,434,775).

1. Regarding claim 1, Sims s discloses a network contents managing system on a network including a personal computer, portable terminals, storage apparatuses, set top boxes, and the like, the system comprising:

a contents database retaining information which is distributed to and stored in different apparatuses connected to the network (Sims s, col. 13, lines 4-20, 40-50, Sims s discloses a database management computer that maintains a database of information distributed to users for reports);

a retrieval request detection unit for detecting a retrieval request to the contents database and outputting a retrieval request information (Sims s, col. 13, lines 40-50, Sims discloses an activity database that generates reports for users);

a network monitoring unit for monitoring a change in an apparatus connection state to the network and, upon occurrence of a change in the connection state, outputting a new apparatus connection state as a connection state information (Sims s, col. 7, lines 40-50, Sims s teaches continuously monitoring devices);

a contents monitoring unit for outputting contents modification information when the information stored in any of the apparatuses connected to the network is modified (Sims s, col. 7, lines 40-50, Sims s teaches continuously monitoring devices, col. 13, lines 4-20, Sims discloses keeping the database up to date with modified device information, col. 14, lines 35-40, Sims teaches generating reports of the devices);

a database retrieval unit for retrieving the contents database upon receipt of the retrieval request information and outputting a retrieval result information (Sims s, col. 13, lines 40-50, Sims discloses an activity database that generates reports for users);
and

a database managing unit for performing registration and modification to the contents database upon receipt of the connection state information and the contents modification information Sims s, col. 13, lines 4-20, Sims discloses an activity database that generates reports for users).

a retrieval result output unit for outputting the retrieval result information received from the database retrieval unit, to the apparatus which has made the retrieval request

Art Unit: 2143

(Sims s, col. 13, lines 40-50, Sims discloses an activity database that generates reports for users).

Regarding claim 14, Sims discloses the limitation, substantially as claimed, as described in claim 1, including wherein:

the contents database associates the information with an apparatus identification number, and retains the information while including apparatus usable state data in the information (Sims s, col. 5, lines 55-65, col. 13, lines 4-12), and

the database managing unit performs registration and modification to the contents database upon receipt of the connection state information and the contents modification information (Sims col. 13, lines 12-20).

Regarding claim 15, Sims discloses the limitation, substantially as claimed, as described in claim 14, including wherein:

the database managing unit changes the apparatus usable state data of the information including the apparatus identification number not shown in the connection state to be unusable (Sims s, col. 7, lines 40-46, col. 13, lines 10-20, Sims s discloses a condition code which is maintained).

Regarding claim 16, Sims discloses the limitation, substantially as claimed, as described in claim 14, including wherein the database managing unit changes the apparatus usable state data of the information including the apparatus identification

Art Unit: 2143

number shown in the connection state to be usable (Sims s, col. 7, lines 40-46, col. 13, lines 10-20, Sims s discloses a condition code which is maintained).

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claim 1 is rejected under 35 U.S.C. 103(a) as being unpatentable over Williams et al. (U.S. Patent Number 6,415,289) in view of Hasegawa et al. (U.S. Patent Number 6,370,587).

2. Regarding claim 1, Williams discloses a network contents managing system on a network including a personal computer, portable terminals, storage apparatuses, set top boxes, and the like, the system comprising:

a contents database retaining information which is distributed to and stored in different apparatuses connected to the network (Williams, col. 6, lines 10-15, Williams teaches a database server storing information about contents stored on storage devices);

a retrieval request detection unit for detecting a retrieval request to the contents database and outputting a retrieval request information (Williams, col. 6, lines 37-50, and **Fig. 11**, Williams teaches an API 1130 detecting a retrieval request from the client);

a contents monitoring unit for outputting contents modification information when the information stored in any of the apparatuses connected to the network is modified (Williams, col. 6, lines 20-30, and lines 35-40, Williams teaches the database server maintaining a database of identifying information concerning other information stored on the network, so when a client requests index information, it will be up to date);

a database retrieval unit for retrieving the contents database upon receipt of the retrieval request information and outputting a retrieval result information (Williams, col. 6, lines 55-60, Williams teaches the database server returning the requested information); and

a retrieval result output unit for outputting the retrieval result information received from the database retrieval unit, to the apparatus which has made the retrieval request (Williams, col. 7, lines 20-35, Williams teaches the database server issuing a command to deliver the requested information).

a database managing unit for performing registration and modification to the contents database upon receipt of the connection state information and the contents modification information (col. 6, lines 10-15).

Williams also discloses a network server being a general purpose computing device which processes and routes network commands to their intended devices (col. 5, lines 64-67), and that there is a large number of both clients and servers connected to the network and each device is conventionally assigned a unique identifier or an address (col. 6, lines 15-20), which means that the devices are monitored for connection to the network.

However, Williams does not explicitly state having a network monitoring unit for monitoring a change in an apparatus connection state to the network and, upon occurrence of a change in the connection state, outputting a new apparatus connection state as a connection state information;

In an analogous art of networking, Hasegawa discloses network connection devices being monitored for connection states, and informing other network devices of the updating of the connection states (col. 14, lines 50-67).

Therefore, it would have been obvious to one in the ordinary skill in the art at the time the invention was made to combine the system of Williams with Hasegawa to improve the storage management system by monitoring the storage devices of the system for connections as well as to enable network nodes to receive messages (col. 1, line 65-col.2, line1). Thus, Williams provides motivation to combine by stating requirement to poll the storage devices to retrieve information (col. 4, lines 35-45).

3. Regarding claim 2, Williams and Hasegawa teach all of the limitations substantially as claimed, as described in claim 1, including wherein the contents monitoring unit further outputs the contents modification when the information is modified by mounting/removing a removable medium (Williams, col. 6, lines 10-43, Williams teaches the database server maintaining a database having information about the information stored on the storage devices, and outputting an index of this information at a clients request).

Claims 3-4 rejected under 35 U.S.C. 103(a) as being unpatentable over Williams in view of Hasegawa as applied to claims 1-2 above, and further in view of Takahashi et al. (U.S. Publication Number 2002/0035620 A1).

4. Regarding claims 3 and 4, Williams and Hasegawa teach all of the limitations substantially as claimed, as described in claims 1 and 2. Hasegawa also teaches an update notification section monitoring connections of devices (Hasegawa, col. 14, lines 50-67).

However Williams and Hasegawa do not explicitly state wherein the network monitoring unit detects a power on/off of the apparatuses connected to the network and retains in the contents database an information of the power on/off of the apparatuses connected to the network as well.

In an analogous art to networking, Takahashi discloses a system of controlling network devices including detection of power on/off of the connected devices (pages 22-23, paragraphs 312 -316).

Therefore it would have been obvious to one in the ordinary skill in the art at the time the invention was made to combine Williams and Hasegawa with Takahashi to provide control over power management of multimedia devices, supplying electrical power to a required multimedia device at only a required time, so that power consumption can be suppressed (Takahashi, page 23, paragraph 0323).

Art Unit: 2143

5. Regarding claims 5-8, Williams, Hasegawa, and Takahashi teach all of the limitations substantially as claimed, as described in claims 1-4, including the system further comprising a power monitoring unit for monitoring a power operation of an apparatus connected to the network and a remote start unit for activating at least one of the contents database, the retrieval request detection unit, the network monitoring unit, the database retrieval unit, the database managing unit, and the retrieval result output unit at another apparatus connected to the network (Takahashi, page 23, paragraphs 0318-0323, Takahashi teaches the system determining Power on/off and updating the database). See 5 for motivation.

6. Regarding claims 9-12, Williams, Hasegawa, and Takahashi teach all of the limitations substantially as claimed, as described in claims 5-8, including comprising a power operation unit for operating a power of another apparatus connected to the network (Takahashi, page 23, paragraphs 0318-0323).

7. Regarding claim 13, Examiner takes Official Notice (see MPEP § 2144.03) that "database administration" in a computer networking environment was well known in the art at the time the invention was made. The Applicant is entitled to traverse any/all official notice taken in this action according to MPEP § 2144.03, namely, "if applicant traverses such an assertion, the examiner should cite a reference in support of his or her position". However, MPEP § 2144.03 further states "See also *In re Boon*, 439 F.2d 724, 169 USPQ 231 (CCPA 1971) (a challenge to the taking of judicial notice must

contain adequate information or argument to create on its face a reasonable doubt regarding the circumstances justifying the judicial notice)." Specifically, In re Boon, 169 USPQ 231, 234 states "as we held in Ahlert, an applicant must be given the opportunity to challenge either the correctness of the fact asserted or the notoriety or repute of the reference cited in support of the assertion. We did not mean to imply by this statement that a bald challenge, with nothing more, would be all that was needed". Further note that 37 CFR § 1.671(c)(3) states "Judicial notice means official notice". Thus, a traversal by the Applicant that is merely "a bald challenge, with nothing more" will be given very little weight. See Sims (U.S. Patent Number 5,434,775), col. 7, lines 60-67.

Response to Amendment

Applicant's arguments and amendments filed on 02 July 2004 have been carefully considered but they are not deemed fully persuasive. Applicant's arguments are deemed moot in view of the following new grounds of rejection as explained here below, necessitated by Applicant's substantial amendment (i.e. modifying claim 1 from information stored to information distributed and stored) to the claims which significantly affected the scope thereof.

Applicant's arguments with respect to claims 1 and 2 have been fully considered but they are not persuasive. Applicant's arguments include the failure of previously applied art to expressly disclose the teachings of a network-monitoring unit for monitoring a change in an apparatus connection state to the network [see Applicant's Response, filed 02 July 2004, page 13, last paragraph]. Applicants arguments also

include the failure of previously applied art to expressly disclose a change in an apparatus connection state [see Applicant's Response, filed 02 July 2004, page 14, lines 1-2]. It is evident from the mappings found in the above rejection that Hasegawa (U.S. 6,370,587) discloses a device comprising an update notification section for determining changes in connection states of other devices, whether newly connected to the network, or restored from a fault and is reconnected to the network (Hasegawa, col. 14, lines 59-63), and keeping a table updated with these connection states (Hasegawa, col. 14, lines 45-67).

In response to applicant's argument that there is no suggestion to combine the references, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case, to improve the storage management system by monitoring the storage devices of the system for connections as well as to enable network nodes to receive messages.

1. Thus, Applicant's arguments drawn toward distinction of the claimed invention and the prior art teachings on this point are not considered persuasive. It is also clear to the Examiner that Sims et al. clearly teaches the independent claims of the Applicant's claimed invention.

2. Applicant's arguments with respect to claims 1 and 2 are deemed moot in view of the following new grounds of rejection, necessitated by Applicant's amendment to the claims which significantly affected the scope thereof.

3. Furthermore, as it is Applicant's right to continue to claim as broadly as possible their invention, it is also the Examiner's right to continue to interpret the claim language as broadly as possible. It is the Examiner's position that the detailed functionality that allows for Applicant's invention to overcome the prior art used in the rejection, fails to differentiate in detail how these features are unique. As it is extremely well known in the networking art as already shown by Sims as well as other prior arts of records disclosed, managing a database of connection states of devices is taught as well as other claimed features of Applicant's invention. By the rejection above, the applicant must submit amendments to the claims in order to distinguish over the prior art use in the rejection that discloses different features of Applicant's claimed invention.

4. It is the Examiner's position that Applicant has not yet submitted claims drawn to limitations, which define the operation and apparatus of Applicant's disclosed invention in manner, which distinguishes over the prior art.

5. Failure for Applicant to significantly narrow definition/scope of the claims and supply arguments commensurate in scope with the claims implies the Applicant intends broad interpretation be given to the claims. The Examiner has interpreted the claims with scope parallel to the Applicant in the response and reiterates the need for the Applicant to more clearly and distinctly define the claimed invention.

Conclusion

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to J. Bret Dennison whose telephone number is (571)272-3910. The examiner can normally be reached on M-F 8:30am-5pm.


If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David A Wiley can be reached on (703) 308-5221. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should

Art Unit: 2143

you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

J. Bret Dennison
Patent Examiner
Art Unit 2143



DAVID WIREY
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 2100